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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,473

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Michael Hendricksen

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10/19/2006

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EXAMINER

DIXON, ANNETTE FREDRICKA

ART UNIT

PAPER NUMBER

3771

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NI

Office Action Summary	Application No. 10/645,473	Applicant(s) HENDRICKSEN ET AL.	
	Examiner Annette F. Dixon	Art Unit 3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/27/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Claims 37-40 in the reply filed on August 4, 2006, is acknowledged.
2. Claim 1-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 4, 2006.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "225" and "325" have both been used to designate the trachea.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "2918".
5. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

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CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: Examiner request applicant update the following U.S. patent application to the appropriate patent number as these applications have been issued: 09/797,910 and 10/270,792.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. Claims 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Deem et al. (6,679,264).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to Claims 37 and 38, Deem discloses an apparatus wherein the recited method is inherent in the use of the apparatus. Deem discloses a bronchoscope (12) that is positioned in the patient's lung, the bronchoscope (12) having a working channel

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(26); a shaft (16) of a delivery catheter (20) through the working channel (26); the coupling of a housing to a distal end of the shaft while the shaft (16) is positioned in the working channel (26); advancing the delivery catheter (20) with the housing carrying the bronchial device (22) until the housing is positioned in the bronchial passageway; and releasing the bronchial device (22) from the housing. (Figure 1). Further Deem discloses the insertion of the bronchial device (22) into the housing prior to the distal end of the shaft.

As to Claim 39, the elements of claim 39 have been discussed in the rejection of claim 38 with the exception of the handle being coupled to the proximate end of the shaft with the shaft positioned in the working channel and having a movable actuator and the actuator being moved to release the bronchial device. Yet the disclosure of the Deem patent does disclose the apparatus to have a handle (84) coupled to the proximal end of the shaft (16) with the shaft (16) positioned in the working channel (26), the handle (84) having a movable actuator (86), which may be moved to release the bronchial device (22). (Column 6, Lines 49-66). Thus the device of Deem is inherently fully capable of performing the recited method.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deem et al. (6,679,264).

As to Claim 40, Deem discloses an apparatus wherein the recited method is inherent in the use of the apparatus. Deem discloses a bronchoscope (12) that is positioned in the patient's lung, the bronchoscope (12) having a working channel (26); a shaft (16) of a delivery catheter (20) through the working channel (26); the coupling of a housing to a distal end of the shaft while the shaft (16) is positioned in the working channel (26); advancing the delivery catheter (20) with the housing carrying the bronchial device (22) until the housing is positioned in the bronchial passageway; and releasing the bronchial device (22) from the housing. (Figure 1). Yet Deem does not expressly disclose the use of a lock to position the delivery catheter in place. However, at the time the invention was made, it would have been obvious to one having ordinary skill in the art to provide a lock for delivery catheter in place prior to releasing the bronchial device as an additional safety measure for preventing the bronchial device from dislodging and blocking flow areas not requiring treatment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette F. Dixon whose telephone number is (571) 272-3392. The examiner can normally be reached on Monday thru Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Annette F. Dixon
Examiner
Art Unit 3771



Danton D. DeMille
Primary Examiner